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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,109	07/10/2003	Norbert Marxer	TNCR.007US3	5810

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EXAMINER	
ROSENBERGER, RICHARD A	
ART UNIT	PAPER NUMBER
2877	

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/619,109	MARXER ET AL.	
	Examiner	Art Unit	
	Richard A Rosenberger	2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 36-108 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 36-108 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 36-108 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,606,153). Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to the same invention. For example, claim 36 differs from claim 1 of the patent in that the patent requires that the light beam be polarized and oblique, which claim 36 does not; however, the polarization of the beam is required in claims 39, 40 and 54 dependent from claim 36, and that the beam be directed at an oblique angle is required by claim 54, dependent from claim 36. Claim 36 requires scanning which claims 1 of the patent does not, but the scanning is claimed in the patent in claims 19, dependent from claim 1 of the patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 36-38, 44-48, 50-58, 61, 62, and 64-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al (US 5,125,741) in view of Quackenbos et al (US 4,794,265).

Okada et al shows an optical system for detecting contaminants and defects on a test surface comprising: a device providing a light beam (1,2,3,4) along a path to the test surface (11), producing an illuminated spot thereon; a first and a second array of detectors (5 is disclosed as a "TV camera"; it would have been obvious to use a known solid-state detector array for the image sensing means of the camera; the fibers 13 and associated detectors also form an array of detectors); a first collector (the lens of camera 5) having an optical axis substantially along a line perpendicular to the test surface, said first collector collecting light scattered by the surface and conveying the collected light to the first array of detectors; a second collector (mirror 7) having an optical axis substantially along the line, said second collector collecting light scattered by the surface and conveying the collected light to the second array of detectors, wherein the first and second collector collect light scattered by

the surface within different ranges of collection angles from the line. It would have been obvious to use other known scanning arrangements to scan the surface (11) in the system of Okada et al; Quackenbos et al shows scanning by using an instrument causing relative rotational and translational motion between the beam and the surface, so that the beam scans a spiral path on the surface.

The camera lens is at least obviously rotationally symmetrical about its optical axis, and will collect light rotationally symmetrically about its optical axis. Those in the art could choose appropriate angles for the detection of the light scattered from the surface. The Okada et reference discloses that the sizes of flaws can be detected (abstract, line 2); this must include distinguishing between large and small flaws. Distinguishing between the nature of flaws (abstract, line 2) is also disclosed. The camera is disclosed as detecting surface irregularities and cracks (column 5, lines 41 and 42), which are topographic features. Providing other detectors at other angles in a known manner would have been obvious to obtain additional useful information about the surface; Quackenbos et al discloses that different angles of scatter can provide different information about different types of flaws.

5. Claims 70-75, 77-83, 85-90, 92-102, and 104-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al (US 5,125,741) in view of Miura et al (US 5,585,916).

See above for a discussion of the Okada et al reference. Miura et al teaches that in scattered light systems the use of polarized light can enhance the detection of certain flaws; see column 6, lines 1-52. It would have been obvious use polarized light in the system of Okada et al to make use of this known useful effect.

6. Claims 39, 40, 49, 76, 84, 91, and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al (US 5,125,741) in view of Quackenbos et al (US 4,794,265) and Miura et al (US 5,585,916). See above for discussions of the references. It would have been obvious to use both the known scanning means shown by Quackenbos et al and the known use of polarized light, as taught by Miura et al, in the device of Okada et al.

7. The art does not appear to teach or suggest a system as claimed in which the collectors comprise an ellipsoidal mirrored surface. Thus claims 41-43 appear to contain allowable subject matter and would be allowable if rewritten in independent form including all of the limitations of their respective parent claims.

8. Papers related to this application may be submitted to Group 2800 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The fax number is (703) 872-9306

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. A. Rosenberger whose telephone number is (571) 272-2428.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

R. A. Rosenberger
15 March 2004

Richard A. Rosenberger
Primary Examiner